

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Wolfgang Paulus et al.

Application No.: 10/535,525

Confirmation No.: 9339

Filed: July 1, 2005

Art Unit: 1651

For: ENZYMATIC SYNTHESIS OF POLYOL
ACRYLATES

Examiner: T. E. Underdahl

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed October 25, 2007, applicant hereby provisionally elects Group I, claims 23-37, for continued examination, with traverse.

The Examiner has required restriction between:

Group I, claim(s) 1-14 are drawn to a process for the enzymatic synthesis of polyol acrylates with an enzyme that transfers acrylate groups.

Group II, claim(s) 15-22 are drawn to a process for preparing polymeric polyol acrylates.

Applicants point out that a preliminary amendment was filed with the application and claims 1-22 were cancelled and rewritten as claims 23-45. Claims 23-37 would be considered in Group I and claims 38-45 would now be in Group II.

Applicants respectfully traverse the Restriction requirement because the U.S. Patent and Trademark Office has not carried forward its burden of proof to establish distinctness.

In particular, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Group II still requires the search of the process according to Group I.

Accordingly, Applicants respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

The Commissioner may require restriction if two or more independent and distinct inventions are claimed in a single application (37 CFR 1.142(a)). In the present case, although the claimed subject matter may be classified in different classes, the inventions are not independent.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13111-00021-US from which the undersigned is authorized to draw.

Dated: November 16, 2007

Respectfully submitted,

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